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## PATENT APPLICATION

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q48708

Shinichi OSHIMA

Appln. No.: 08/988,181

Group Art Unit: 3711

Confirmation No.: 7161

Examiner: Raeann GORDEN

Filed: December 10, 1997

For: GOLF BALL SELECTION DEVICE

#### REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

#### MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated October 20, 2006. Entry of this Reply Brief is respectfully requested.

#### Table of Contents

STATUS OF CLAIMS .....	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL .....	3
ARGUMENT.....	4
CONCLUSION .....	7

**STATUS OF CLAIMS**

Claims 1-11 have been canceled, and are not the subject of this appeal.

Claims 12-43 are currently pending in the present application, each stand rejected by the Examiner in the Final Office Action (Paper No. 20050916) dated September 21, 2005, and are the subject of this appeal.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 12-43 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 1,676,975 to Anderson *et al.* (hereinafter “Anderson”).

### ARGUMENT

In this Reply Brief, Appellant wishes to address certain points as raised in the Examiner's Answer, mailed on October 20, 2006.

(A) In her rationale supporting the rejection, the Examiner asserts that "[Appellants'] ... indicia are not considered patentable because it is not functionally related to the substrate (box)." (Examiner's Answer at page 3, lines 5-7) In further support of this position, the Examiner relies on MPEP §2112.02(III), which states the general proposition that printed matter not functionally related to the product will not distinguish the claimed product from the prior art. (Examiner's Answer at page 3, lines 7-10).

Appellant does not refute the general principle but, instead, the Examiner's application of it to the present case. That is, the Examiner's argument goes directly against this Board's earlier decision in this case. Specifically, in Appeal No. 2002-1912 (in this very same application 08/988,181) as mailed on March 19, 2003, the Board specifically found that such a functional relationship does indeed exist, and that it must be given patentable weight. Particularly, at page 7, last full paragraph, the Board noted (emphasis added):

" ... a **functional relationship clearly exists** between the printed matter (the icons and sets of descriptive information relating to performance characteristics of the golf ball) and the substrate (the golf ball package). Thus, the **printed matter limitations** in the appealed claims **must be evaluated in terms of their patentable weight** in assessing the obviousness of the claimed invention."

This is the law of the case, and is controlling. See *In re Freeman*, 30 F.3d 1459, 31 USPQ2d 1444 (Fed. Cir. 1994). Moreover, there is nothing in this earlier Board Decision that goes against the findings in Appeal 2002-2175 (cited by the Examiner at page 2, item 2, of the Examiner's Answer) in parallel application 09/060,960, as decided by the same panel as was the prior appeal in this case.

Thus, Appellants respectfully request that the Board of Appeals uphold its earlier ruling, and reverse this rejection which is supported by an assertion in direct contradiction thereof.

(B) The Examiner posits that “[t]he question before the BPAI is whether or not the indicia is functionally related to the product.” (Examiner’s Answer at sentence bridging pages 3 and 4) Appellant respectfully submits that the Board has already unequivocally answered this question by noting that “a functional relationship clearly exists between the printed matter ... and the substrate ... [and that] the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight ...” (Bd. Decision in Appeal 2002-1912 at page 7, last paragraph)

(C) The Examiner’s reliance<sup>1</sup> on *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) does not change the outcome in this case. In *Ngai*, the Federal Circuit merely again applied the general principle that printed matter not functionally related to the product will not distinguish the claimed product from the prior art. As noted in (A) and (B) above, the Board of Appeals has already decided that such a functional relationship “clearly exists” in the present case. (Bd. Decision in Appeal 2002-1912 at page 7, last paragraph)

(D) The Examiner attempts to argue that because a golf ball is not claimed, that the indicia are not functionally related to the box but simply describes the product inside the box. (Examiner’s Answer at page 4, lines 6-17) Appellant notes that independent claims 12 and 31 are the exact same claims as considered in the earlier appeal—no amendments to the claims have been made. Thus, this line of reasoning should not be sufficient to override the Board’s earlier finding that “a functional relationship clearly exists between the printed matter ... and the substrate ... [and that] the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight ...” (Bd. Decision in Appeal 2002-1912 at page 7, last paragraph)

(E) Anderson fails to teach or suggest all of the elements as set forth and arranged in the claims. Yet, to establish *prima facie* obviousness of a claimed invention, all the claim

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<sup>1</sup> Examiner’s Answer at page 4, lines 1-6.

limitations must be taught or suggested by the prior art.<sup>2</sup> Further, all words in a claim must be considered in judging the patentability of that claim against the prior art.<sup>3</sup> Specifically, Anderson fails to teach or suggest a label with plural subsections respectively comprising an icon and a set of descriptive information relating to a performance characteristic of the ball as required by independent claims 12 and 31.

The Examiner asserts that Anderson discloses a golf ball box for packaging golf balls, wherein the box includes a cover and indicia on the surface of the cover, wherein the indicia provides information about the product inside the package. (Examiner's Answer at page 3, lines 2-5 and the last 4 lines, noting that Anderson's figure 2 indicia reads "golf ball") Anderson notes that the box may include advertising or an explanation of the novelty of using the box to practice putting. (Anderson at page 1, lines 1-10 and 53-56) However, Anderson does not teach or suggest a golf ball box having a label with plural subsections respectively comprising an icon and a set of descriptive information relating to a performance characteristic of the ball as required by independent claims 12 and 31. Further, there is no discussion of why, from Anderson's disclosure, one of ordinary skill would have found it obvious to provide Anderson's golf ball box with a label having plural subsections respectively comprising an icon and a set of descriptive information relating to a performance characteristic of the ball as required by independent claims 12 and 31.

Because Anderson fails to teach or suggest all of the elements as set forth and arranged in the claims, the Examiner's rejection based thereon should fail.

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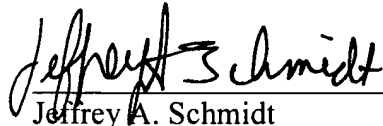
<sup>2</sup> *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>3</sup> *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

**CONCLUSION**

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejection of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

  
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